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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/672,415

09/27/2004

Roland N. Walker

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7590

12/26/2007

KIRTON AND MCCONKIE

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SALT LAKE CITY, UT 84111

EXAMINER

COLILLA, DANIEL JAMES

ART UNIT

PAPER NUMBER

2854

MAIL DATE

DELIVERY MODE

12/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/672,415

Applicant(s)

WALKER ET AL.

Examiner

Daniel J. Colilla

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 16 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 16 and 19-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 8, 9, 10 and 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fromm (US 5,435,240) in view of Skonecki (US 5,305,550), Reinhardt et al. (US 4,957,787), Hirata (JP 59-016801), Roulleau (US 5,142,976) and Carroll (US 5,366,192).

With respect to claim 1-4, 8, 9 and 10, the rejection in the Office action mailed on 6/12/2007 is repeated here.

With respect to claim 21, Fromm discloses the claimed method for providing an image on an article but does not disclose providing the image on a flower or producing a group of flowers with a communication. Fromm discloses a system and method for providing an image on an organic product including the steps of creating an image on a transfer medium 36, transferring the image onto a flexible organic product such as skin or leather (Fromm, col. 4, lines 57-61, col. 5, lines 2-5). As is known in the art, pads for printing are created so that a plurality of copies of the image being printed can be made. Skonecki, Reinhardt et al., Hirata, and Roulleau teach that it is known and desirable to print on delicate articles such as live flowers, artificial flowers, Leaves of a plant and eggs respectively. In view of the teachings of the prior art, it would have been obvious to one of ordinary skill in the art to provide an image on a live flower using the system or method disclosed by Fromm for the advantage of applying a brand name, advertising

or adding personal messages to the flower. Carroll teaches that it is known to produce a group of flowers free of an etched or cut image (Carroll, col. 1, lines 8-10) each flower having a stem and one or more petals (see Figure 1 of Carroll). Carroll also teaches the combination of a group of flowers containing a communication from a sender to a recipient (Carroll, col. 1, lines 8-10). It would have been obvious to combine the teaching of Carroll with the method disclosed by Fromm (US 5,435,240) for the advantage of sending a message to someone one a unique message medium. Skonecki teaches printing on a petal of flower. Thus it would have been obvious to print the same image on at least one petal of a group of flowers since it involves simply repeating a known step on a known product for producing more of the same product.

With respect to claim 22, Skonecki teaches that the flower with a message is a rose (Skonecki, abstract, lines 1-2).

With respect to claim 23, Skonecki teaches printing an image on a petal of a flower, thus the provision of printing the same image on additional petals would have been obvious since it involves simply repeating a known step on a known product for producing more of the same product.

With respect to claim 24, Fromm teaches a pad printing, transfer technique (Fromm, col. 2, lines 8-13).

With respect to claim 25, Lampinski teaches a machine for pad printing through a transfer printing technique (Lampinski, col. 6, lines 63-64).

3. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fromm (US 5,435,240) in view of Skonecki (US 5,305,550), Reinhardt et al. (US 4,957,787), Hirata (JP 59-

016801), Roulleau (US 5,142,976) and Carroll (US 5,366,192), as applied to claims 2 and 16 above, and further in view of Lampinski (US 6,314,880).

With respect to claim 5, Fromm in view of Skonecki , Reinhardt *et al.*, Hirata, Roulleau and Carroll teaches all that is claimed as discussed above except for the step for creating a first image comprising the step for etching the first image into the cliché. Lampinski teaches the step for creating a first image comprising the step for etching the first image into the cliché (Lampinski, col. 3, lines 40-62 and col. 4, lines 67- col. 5, line 3). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fromm in view of Skonecki, Reinhardt *et al.*, Hirata and Roulleau such that the first image is created by etching it into the cliché to produce a high quality image on a plate as taught by Lampinski.

With respect to claim 6, Fromm in view of Skonecki, Reinhardt *et al.*, Hirata, Roulleau and Carroll teaches all that is claimed as discussed above except for the cliché comprising a photosensitive material. Lampinski teaches a method wherein the cliché comprises a photosensitive material (Lampinski, col. 5, lines 37-40. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fromm in view of Skonecki, Reinhardt *et al.*, Hirata, Roulleau and Carroll such that the cliché comprises a photosensitive material so that the cliché can polymerize under the action of radiation as taught by Lampinski.

With respect to claim 7, Fromm in view of Skonecki, Reinhardt *et al.*, Hirata, Roulleau and Carroll teaches all that is claimed except for the step for etching comprising the steps for: providing a third image; creating a film positive of the third image; and exposing the photosensitive material through a wash out process to etch the third image into the photosensitive

material. Lampinski teaches a method wherein step for etching comprises the steps for: providing a third image (Examiner notes that Lampinski teaches creating multiple images; creating a film positive of the third image; and exposing the photosensitive material through a wash out process to etch the third image into the photosensitive material (Lampinski, col. 3, lines 41-50). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Fromm in view of Skonecki, Reinhardt *et al.*, Hirata, Roulleau and Carroll wherein the etching comprises providing a third image, creating a film positive of the third image, and exposing the photosensitive material through a wash out process to etch the third image into the photosensitive material to create images with a variety of colors using an etching technique combined with pad printing as taught by Lampinski.

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Skonecki (US 5,305,550) in view of Carroll (US 5,366,192).

With respect to claim 16, the rejection in the Office action mailed on 6/12/2007 is repeated here.

5. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skonecki (US 5,305,550) in view of Carroll (US 5,366,192), as applied to claim 16 above, and further in view of Lampinski (US 6,314,880).

With respect to claims 19-20, the rejection in the Office action mailed on 6/12/2007 is repeated here.

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are not persuasive of any error in the above rejection.

The amendment adding the term "live" to the term "flower" does not change the rejection of the claims since it is believed that the Skonecki patent teaches printing on a live flower simply by disclosing printing on a flower.

Also, the amendment providing the step of printing on all flowers in a group or on all petals of a flower would have been obvious to one of ordinary skill in the art as mentioned above.

With respect to applicant's that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The combination of references

would give one of ordinary skill in the art the necessary knowledge to be able to print on flowers as mentioned above.

Regarding the declarations filed by applicant, these declarations are directed to the claimed invention of parent application, SN 09/964,989 which is, of course, a different invention than that which is claimed in this application. MPEP§ 716.03(b) states that when considering evidence of commercial success, care should be taken to determine that the commercial success alleged is directly derived from the invention claimed, in a marketplace where the consumer is free to choose on the basis of objective principles, and that such success is not the result of heavy promotion or advertising, shift in advertising, consumption by purchasers normally tied to applicant or assignee, or other business events extraneous to the merits of the claimed invention, etc. In re Mageli, 470 F.2d 1380, 176 USPQ 305 (CCPA 1973) (conclusory statements or opinions that increased sales were due to the merits of the invention are entitled to little weight); In re Noznick, 478 F.2d 1260, 178 USPQ 43 (CCPA 1973). In ex parte proceedings before the Patent and Trademark Office, an applicant must show that the claimed features were responsible for the commercial success of an article if the evidence of nonobviousness is to be accorded substantial weight. See In re Huang, 100 F.3d 135, 140, 40 USPQ2d 1685, 1690 (Fed. Cir. 1996) (Inventor's opinion as to the purchaser's reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention.). Merely showing that there was commercial success of an article which embodied the invention is not sufficient.

Thus the declarations hold no weight in this application.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Nguyen can be reached at 571-272-2258. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 17, 2007



Daniel J. Colilla
Primary Examiner
Art Unit 2854